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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/851,624 | 05/08/2001 | Paul Raposo | | 3680 |

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| EXAMINER | |
|---|---|
| MEINECKE DIAZ, SUSANNA M | |
| **ART UNIT** | **PAPER NUMBER** |
| 3623 | |

DATE MAILED: 06/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 09/851,624 | RAPOSO, PAUL | |
| | Examiner | Art Unit | |
| | Susanna M. Diaz | 3623 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *09 April 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-14* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-14* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.



5.10-0r

## DETAILED ACTION

1. This final Office action is responsive to Applicant's amendment filed April 9, 2005.

Claims 1-8 and 10 have been amended.

Claims 1-14 are presented for examination.

2. The previously pending claim objections are withdrawn in response to Applicant's claim amendments.

The previously pending art rejection is withdrawn in light of the numerous rejections applied to the claims under 35 U.S.C. § 112, 1st and 2nd paragraphs.

### *Response to Arguments*

3. Applicant's arguments filed April 9, 2005 have been fully considered but they are not persuasive.

In reference to the question of what is meant by benchmarking versions of a survey, Applicant states that he invented a new version of benchmarking which was previously unknown to those of ordinary skill in the art (page 7 of Applicant's response). As such, one must looked toward Applicant's specification to understand Applicant's intended interpretation of benchmarking versions of a survey (page 7 of Applicant's response). Applicant admits that the benchmarking of the instant invention is "like comparing apples and oranges" (page 9 of Applicant's response). Applicant argues that the benchmarking is based on various weights, goals, and indices; however, no real-

world significance is applied to either in a context that explains how any useful comparison of the different versions of a survey is reasonably and consistently achieved. The fact that, as Applicant asserts, Applicant's approach to benchmarking is completely novel to the point that "one of ordinary skill in the art would not have known what this meant without reference to the specification" signifies that Applicant's bar for describing his invention in sufficient detail as to fully enable the invention is that much higher. The Examiner maintains the rejections under 35 U.S.C. § 112, 1st and 2nd paragraphs, and provides more explanation in support of her position below.

In conclusion, Applicant's arguments are not persuasive.

***Claim Rejections - 35 USC § 101***

4. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 1 and 7-14 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

(1) whether the invention is within the technological arts; and

(2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as

opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts.

Claims 1 and 7 are directed toward a system, but comprise no system elements *per se*; therefore, it is not clear which statutory class they belong to. Furthermore, the "survey builder" recited in claim 7 is interpreted as software *per se*, which is non-statutory.

While claims 8-14 produce a useful, concrete, and tangible result, the recited steps do not apply, involve, use, or advance the technological arts and are therefore not statutory.

Appropriate correction is required.

### *Claim Rejections - 35 USC § 112*

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 1-14 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. Also, claims 1-14 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The

claim contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention, as intended by Applicant.

Claims 1-14 recite the benchmarking of versions of a survey, creating a benchmark, storing a benchmark, etc. The specification lacks adequate written disclosure to explain what is meant by benchmarking versions of a survey. Are the survey results used to measure the success of benchmarked goals of a survey requester or does the actual survey itself comprise various versions that are all compared to an original version? The specification states, "Benchmarks provide a quantifiable way to conceptually grade and measure the success of a survey against goals." (Page 2 of the specification) Again, is the success of a survey measured or do the results of the survey reflect the success of an entity in reaching established goals related to survey questions?

Also, what is meant by designing a survey with goals and weights (see claims 8-14)? Are survey questions literally weighted to reflect a level of importance or are they merely chosen to correspond to the information that a survey requester desires to ascertain from the survey results?

In claims 1-14, it is not clear what is meant by benchmarking surveys. Are the survey results used to measure the success of benchmarked goals of a survey requester or does the actual survey itself comprise various versions that are all compared to an original version? What is meant by creating a benchmark index based on applying weights to the survey answer values? Furthermore, how does this serve to

allow for a comparison of different versions of the survey? If the weights of a variety of questions can be altered for each survey version, how can the success of each survey be benchmarked against another survey with different weights? By weighting each question, the person designing the survey is imparting some sort of bias to each survey. Applicant compares the index reflecting the success of each survey to a stock market index; however, the stock market is dynamically changing over time and is compared to a desired value. The more a stock is worth, the better it is performing. On the other hand, each survey is based on a different version or selected groups of questions and respective weights for each question. The various surveys seem to present more factors to take into account than assessment of stock market performance. Also, the stock market index is quantifiable in relation to a fixed goal (i.e., the higher the value of the stock, the better it is performing). Surveys are subjective in nature. How does weighting the questions determine if the survey is successful? Is it analogous to scoring a batch of SATs and making the questions either easier or harder or weighting them differently until the average score is 1200? How is the goal of a set of surveys determined? Is it a subjective goal or a scored goal? The invention recites various weights, goals, and indices; however, no real-world significance is applied to either in a context that explains how any useful comparison of the different versions of a survey is reasonably and consistently achieved. The Examiner has looked toward the specification and has not found sufficient clarification to answer of all of these questions.

Without adequate written disclosure regarding the aforementioned questions, the Examiner submits that one of ordinary skill in the art would not know how to make and/or use the claimed invention, as intended by Applicant.

Appropriate clarification is required.

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 1-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 is directed toward a system; however, no system elements are recited. In light of these two problems, it is not clear that the recited "wherein" and "whereby" clauses merit patentable weight. While claims 2-7 recite a secure server, a server web site, and a survey builder, only the secure server implies some physical structure (whereas the web site and survey builder may be interpreted as mere software or a collection of data). A system typically comprises multiple structural elements.

Claims 1-7 are narrative in form and replete with indefinite and functional or operational language. The structure which goes to make up the device must be clearly and positively specified. For example, the use of "because" several times in claim 1 is narrative in nature and raises the question of which limitations, if any, merit patentable weight. Are the phrases following the occurrences of "because" positively recited

limitations or are they merely consequences of the claimed invention that do not merit patentable weight?

Furthermore, the negative limitation recited in claim 1 (i.e., "wherein a plurality of results of said surveys cannot be compared because of said modified questions or said different questions") is vague and indefinite because the specification does not clarify the scope of what would be positively implied by such a limitation.

The use of vague terms such as "can be" and "allows" throughout claims 1-14 is vague and indefinite because they fail to positively recite Applicant's invention. All because something "can be" done or one is "allowed" to perform a certain action does not mean that the related action is expressly performed.

In claims 1-14, it is not clear what is meant by benchmarking surveys. Are the survey results used to measure the success of benchmarked goals of a survey requester or does the actual survey itself comprise various versions that are all compared to an original version? What is meant by creating a benchmark index based on applying weights to the survey answer values? Furthermore, how does this serve to allow for a comparison of different versions of the survey? If the weights of a variety of questions can be altered for each survey version, how can the success of each survey be benchmarked against another survey with different weights? By weighting each question, the person designing the survey is imparting some sort of bias to each survey. Applicant compares the index reflecting the success of each survey to a stock market index; however, the stock market is dynamically changing over time and is compared to a desired value. The more a stock is worth, the better it is performing. On the other

hand, each survey is based on a different version or selected groups of questions and respective weights for each question. The various surveys seem to present more factors to take into account than assessment of stock market performance. Also, the stock market index is quantifiable in relation to a fixed goal (i.e., the higher the value of the stock, the better it is performing). Surveys are subjective in nature. How does weighting the questions determine if the survey is successful? Is it analogous to scoring a batch of SATs and making the questions either easier or harder or weighting them differently until the average score is 1200? How is the goal of a set of surveys determined? Is it a subjective goal or a scored goal? The invention recites various weights, goals, and indices; however, no real-world significance is applied to either in a context that explains how any useful comparison of the different versions of a survey is reasonably and consistently achieved. The Examiner has looked toward the specification and has not found sufficient clarification to answer of all of these questions.

Appropriate correction is required.

*10. Because claims 1-14 are so indefinite, no art rejection is warranted as substantial guesswork would be involved in determining the scope and content of these claims. See In re Steele, 305 F.2d 859, 134 USPQ 292 (CCPA 1962); Ex parte Brummer, 12 USPQ 2d, 1653, 1655 (BdPatApp&Int 1989); and also In re Wilson, 424 F.2d 1382, 165 USPQ 494 (CCPA 1970). Prior art pertinent to the disclosed invention is nevertheless cited and applicants are reminded they must consider all cited art under Rule 111(c) when amending the claims to conform with 35 U.S.C. 112.*

***Conclusion***

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Desiraju et al. (U.S. Patent No. 6,243,613) -- Discloses a policy assessment survey with weighted questions and answers that is used to determine if goals have been met.

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susanna M. Diaz whose telephone number is (571) 272-6733. The examiner can normally be reached on Monday-Friday, 10 am - 6 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on (571) 272-6729. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Susanna Diaz

Susanna M. Diaz
Primary Examiner
Art Unit 3623

June 24, 2005